

REMARKS

Allowed and Allowable Claims

Claims 3-31, 59 and 61-67 have been allowed, and claims 43, 45, 51-54, 56 and 57 have been indicated as allowable if rewritten in independent form. To that end, claims 43, 45, 54, 56 and 57 have been rewritten in independent form, and the Applicant therefore respectfully requests allowance of rewritten independent claims 43, 45, 54, 56 and 57. Additionally, claim 51 has been amended to depend from rewritten independent claim 54, and dependent claim 53 has been amended to improve its form and to avoid recitation of duplicative subject matter. The Applicant submits that dependent claims 51-53 are allowable for at least the reasons supporting the patentability of allowable independent base claim 54.

Claim Rejections – 35 USC §102

Claims 42, 44, 46-50, 55, 58, 60 and 68-70 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,273,519 to Koros et al.

It is well established that “an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co. Ltd., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989).

Claim Amendments

As indicated above, allowable claims 43, 45, 54, 56 and 57 have been rewritten in independent form, claim 51 has been amended to depend from rewritten independent claim 54, and dependent claim 53 has been amended to improve its form and to avoid recitation of duplicative subject matter. Dependent claim 70 has also been rewritten in independent form. Additionally, independent claims 42 and 55 have been amended to recite further features associated with the claimed invention, and independent claims 58 and 60 have been amended to depend from independent claim 42.

Arguments in Support of Patentability

The only pending independent claims that have not yet been indicated as allowed or allowable are independent claims 42, 55 and 70.

With regard to the rejection of independent claim 42, the Office Action has construed the movable handle 20 of the Koros device as a plate member, and the small recess 21 formed in the

side of the movable handle 20 (see Figure 6) as an opening/aperture. The Office Action further asserts that the movable shaft 30 comprises a shaft that is connected to the handle 20 adjacent a first edge of the handle 20, and which is movable to pivot the plate member (i.e., the handle 20) substantially around an opposite second edge of the handle 20. Additionally, the stationary barrel 25-27 has been construed as a sleeve that is slidable with respect to the movable shaft 30. However, the Office Action does not set forth any grounds, reasoning or rationale as to how Koros discloses or in any way suggests that “said aperture (i.e., the small recess 21 in the side of the handle 20) is sized to allow insertion of at least part of an orthopedic implant, and wherein said plate member has a first position in which said aperture is relatively open and such insertion can be accomplished, and a second position in which said aperture is relatively closed and said plate can contact the orthopedic implant”, as recited in independent claim 42. Indeed, the Office Action does not in any way refer to this claim language, and does not set forth any basis as to how the Koros device satisfies this claim language. For this reason alone, the Office Action fails to set forth sufficient grounds to support an anticipatory rejection of independent claim 42.

Nevertheless, in order to further facilitate prosecution of the application, the Applicant has amended independent claim 42 to positively recite “an orthopedic implant” and with the aperture “extending entirely through said plate member”, and to further recite that the plate member has a first position in which the aperture is relatively open “with the orthopedic implant positioned within said aperture and extending through said plate member” and “a second position in which said aperture is relatively closed and an inner surface of said aperture in said plate is in contact with the orthopedic implant”. This claimed arrangement is illustrated, for example, in Figures 9 and 10 of the as-filed application.

With regard to Koros, even assuming arguendo that the handle 20 could be construed as a plate member, and that the small recess 21 formed in the side of the movable handle 20 (see Figure 6) could be construed as an aperture, the small recess 21 does not extend entirely through the handle 20. Moreover, there is absolutely no teaching or suggestion that an orthopedic implant is positioned within the small recess 21 and extending through the handle 20, or that the handle 20 is positioned such that small recess 21 is relatively closed with an inner surface of the small recess 21 in contact with an orthopedic implant.

For at least the reasons set forth above, the Applicant submits that independent claim 42 is patentable over Koros and any of the other references of record. Accordingly, withdrawal of the rejection of independent claim 42 and allowance of the same is respectfully requested. Claims 44, 50, 58, 60 and 69 depend from independent claim 42 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 42.

With regard to the rejection of independent claim 55, once again, the Office Action has construed the movable handle 20 of the Koros device as a plate member, and the small recess 21 formed in the side of the movable handle 20 (see Figure 6) as an opening/aperture. The Office Action further asserts that the movable shaft 30 comprises a shaft that is connected to the handle 20 adjacent a first edge of the handle 20, and which is movable to pivot the plate member (i.e., the handle 20) substantially around an opposite second edge of the handle 20. However, the Office Action does not set forth any grounds, reasoning or rational as to how Koros discloses or in any way suggests that “said aperture (i.e., the small recess 21 in the side of the handle 20) is sized to allow insertion of at least part of an orthopedic implant, and wherein said plate member has a first position in which said aperture is relatively open and such insertion can be accomplished, and a second position in which said aperture is relatively closed and said plate can contact the orthopedic implant”, as recited in independent claim 55. Indeed, the Office Action does not in any way refer to this claim language, and does not set forth any basis as to how the Koros device satisfies the claim language. Additionally, the Office Action also fails to set forth reasoning or rational as to how the small recess 21 in the side of the movable handle 20 is “at least partially tapered”. For these reasons alone, the Office Action fails to set forth sufficient grounds to support an anticipatory rejection of independent claim 55.

Nevertheless, in order to further facilitate prosecution of the application, the Applicant has amended independent claim 55 to recite “an aperture extending entirely through said plate member, said aperture including an inner circular surface”, and that “said inner circular surface of said aperture of said plate is at least partially tapered”. This claimed arrangement is clearly illustrated, for example, in Figures 11 and 12 of the as-filed application. With regard to Koros, even assuming arguendo that the handle 20 could be construed as a plate member and that the small recess 21 formed in the side of the movable handle 20 (see Figure 6) could be construed as

an aperture, the small recess 21 does not extend entirely through the handle 20. Moreover, the small recess 21 does not have an inner circular surface that is at least partially tapered.

For at least the reasons set forth above, the Applicant submits that independent claim 55 is patentable over Koros and any of the other references of record. Accordingly, withdrawal of the rejection of independent claim 55 and allowance of the same is respectfully requested.

As indicated above, dependent claim 70 has been rewritten in independent form, and the Applicant submits that rewritten independent claim 70 recites elements and features that are neither disclosed nor suggested by Koros. The Office Action asserts that the star gear or wheel 130 illustrated in Figures 10 and 11 constitutes “a ratchet mechanism connected to the base and the sleeve 25/26/27”. (See page 2 of the Office Action). Even assuming *arguendo* that the star gear 130 could somehow be construed as a ratcheting mechanism, the star gear 130 is not “operable to move said sleeve with respect to said shaft and said plate”, as recited in rewritten independent claim 70. To the contrary, the barrel 25-27 remains in a stationary position, and the star gear 130 is not in any way “operable to move said sleeve” with respect to the movable shaft 30 and the movable handle 30. Instead, the star gear 130 operates to allow the surgeon “to rotate the shaft about its axis in 45 degree increments either clockwise or counterclockwise to change the angular orientation of the footplate at the distal ends of the shafts”. (See column 10, lines 36-41; emphasis added). However, the star gear 130 is not in any way operable to move the stationary barrel 25-27.

For at least the reasons set forth above, the Applicant submits that independent claim 70 is patentable over Koros and any of the other references of record. Accordingly, withdrawal of the rejection of independent claim 70 and allowance of the same is respectfully requested. Claims 46-49 and 68 depend from independent claim 70 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 70. However, further reasons support the patentability of the claims depending from independent claim 70.

For example, claim 46 recites “a stop connected to said base, said stop having at least one position connected to said ratchet mechanism in which movement in a rearward direction of said sleeve is limited, and a position disengaged from said ratchet mechanism so that said sleeve can be moved in a rearward direction”. However, as indicated above, the barrel 25-27 remains in a stationary position, and movement of a stop to a position disengaged from a ratchet mechanism

does not allow the barrel 25-27 to be “moved in a rearward direction”. Accordingly, the rejection of claim 46 as being anticipated by Koros is submitted to be improper.

Additionally, claim 48 recites that “said stop comprises three pawls capable of operating independently of each other”, and claim 49 further recites that “said pawls are nested”. However, the Koros device does not include three pawls that are nested with one another, and the Office Action fails to set forth any grounds or basis whatsoever as to what elements of the Koros device constitute three pawls, much less three pawls that are nested with one another. Accordingly, the rejections of claims 48 and 49 as being anticipated by Koros are submitted to be improper.

Furthermore, claim 68 recites that “said stop comprises two pawls capable of operating independently of each other”. Once again, the Koros device does not include two pawls that operate independently of each other, and the Office Action fails to set forth any grounds or basis whatsoever as to what elements of the Koros device constitute two pawls that operate independently of each other. Accordingly, the rejection of claim 68 as being anticipated by Koros is submitted to be improper.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that Applicant's application is in condition for allowance with pending claims 3-31 and 42-70.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

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